

## REMARKS

Claims 1-30 are pending in the Application. Claims 22-30 have been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

### The Rejections

Claims 1, 3, 8, 11, and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Peters et al. ("Peters").

Claims 2, 4, and 12 were rejected under 35 U.S.C. § 103(a) as obvious over Peters in view of Cataldo et al ("Cataldo").

Claims 5-7 were rejected under 35 U.S.C. § 103(a) as obvious over Peters in view of Graef et al.

Claims 9-10, 13, 15, 17, and 20 were rejected under 35 U.S.C. § 103(a) as obvious over Peters in view of Henry et al ("Henry").

Claim 14 was rejected under 35 U.S.C. § 103(a) as obvious over Peters in view of Blumstein et al.

Claim 16 was rejected under 35 U.S.C. § 103(a) as obvious over Peters as modified by Henry as applied to claim 15, and further in view of Cataldo.

Claims 18-19 were rejected under 35 U.S.C. § 103(a) as obvious over Peters in view of Abecassis.

These rejections are respectfully traversed.

### The Legal Standard

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in a prior art reference must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

#### **The 35 U.S.C. § 102 Rejections**

For brevity the Applicants do not necessarily present all of the reasons as to why the Peters reference does not anticipate the claims. The Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments herein show that the reference does not disclose each and every step, feature, and relationship of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Therefore, the applied reference cannot anticipate the claims. Hence, Applicants' claims patentably distinguish over the applied reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections should be withdrawn.

### **The Claims Are Not Anticipated By Peters**

In the Action claims 1, 3, 8, 11, and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Peters. These rejections are respectfully traversed.

#### **Claim 1**

Peters does not teach the recited steps, features, and relationships. Peters does not teach displaying the user image and the item image to the user through a display operatively connected to the deposit accepting machine. Thus, Peters cannot anticipate the claim.

There is no indication or evidence that Peters discloses using a display (operatively connected to a deposit accepting machine) for displaying a user image and an item image to a user. There is no evidence that Peters' ATM display screen (14) is even capable of displaying a user image and an item image to a user. Nor is there any indication in Peters that the image data is stored in the ATM for displaying. Contrarily, Peters teaches that the image data is written to the disc. Peters only teaches that the disc's image data is displayed on a modified home PC (50), not through a display in the manner recited.

Furthermore, there is no evidence that Peters has the hardware and software arrangements necessary to permit the ATM display screen (14) to display a user image and an item image to a user, especially when the images would have to be retrieved from the disc. There is no evidence that Peters has the memory necessary for reading the disc, especially when the disc contains a large file (col. 2, lines 27-34). Nor is there any evidence that Peters' ATM is able to decompress disc data (col. 2, lines 30-34). Additionally, there is no evidence that Peters' ATM is able to read encrypted data which was written to the disc by the ATM. That is, Peters' ATM may be arranged to provide encrypted data to the disc without the capability to reread the data as a security

precaution. Such an arrangement would prevent an unauthorized user from accessing personal account information from a lost or stolen disc by using the ATM to read the disc. Additionally, Peters desires to reduce space within the ATM (col. 1, lines 11-12; col. 2, lines 23-25). Thus, Peters teaches away from having the additional hardware and software features necessary to permit the ATM display screen (14) to display a user image and an item image to a user. Thus, Peters cannot anticipate the claim.

### **The Dependent Claims**

Each of the dependent claims 2-21 depend directly or indirectly from claim 1. Claim 1 has been previously shown to be allowable. It is asserted that these dependent claims are allowable on the same basis.

Furthermore, each of these dependent claims additionally recite specific steps, features, and relationships that patentably distinguish the claimed invention over the applied art. None of the applied references, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in these dependent claims. Thus, it is respectfully submitted that these dependent claims are further allowable due to the recitation of such additional steps, features, and relationships.

For example, with regard to claim 2, neither Peters nor Cataldo teach or suggest simultaneously displaying a user image and an item image to a user through a display operatively connected to a deposit accepting machine. The Action (page 4) admits that Peters "fails to specifically teach that the user image and the item image are simultaneously displayed through the display". Cataldo teaches use of film. However, there is no disclosure or suggestion that

Cataldo's film is capable of being displayed through a display operatively connected to Cataldo's depository (11). There is no disclosure or suggestion that Cataldo's depository even has a display. Nor is there any disclosure or suggestion that Peters' display is capable of displaying Cataldo's film therethrough. Nor would it have been obvious to one having ordinary skill in the art to even consider displaying Cataldo's film through Peters' display.

The Action has not presented any factual evidence that it was known in the prior art to simultaneously display a user image and an item image to a user through a display operatively connected to a deposit accepting machine. Thus, the Office has not presented a *prima facie* showing of obviousness. If the Office does not produce a *prima facie* case, then Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

With regard to claim 13, neither Peters nor Henry teach or suggest that amount data (representative of an amount associated with a deposit item) is displayed through a display with a user image and an item image. Again, the Action lacks a *prima facie* showing of obviousness.

Claim 1 has been previously shown to be allowable because it is not anticipated by Peters. Dependent claims 2-21 include the features and relationships of claim 1. None of the secondary references can alleviate the deficiencies in Peters with regard to the dependent claims (which include the features and relationships of allowable claim 1).

Therefore, neither Peters nor Cataldo, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in claims 2, 4, and 12. Neither Peters nor Graef, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in claims 5-7. Neither Peters nor Henry, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically

recited in claims 9-10, 13, 15, 17, and 20. Neither Peters nor Blumstein, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in claim 14. Neither Peters, Henry, nor Cataldo, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in claim 16. Neither Peters nor Abecassis, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in claims 18-19.

Thus, it is respectfully submitted that the 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections should be withdrawn.

#### **Fees For Additional Claims**

Please charge the fees associated with the submission of nine (9) claims in excess of twenty claims (\$162) and any other fee due to deposit account 09-0428.

#### **Conclusion**

Each of Applicants' pending claims specifically recite steps, features, and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted.



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